

Appl. No. 10/736,282
Docket No. AA556C
Amdt. dated January 15, 2010
Reply to Office Action mailed on November 17, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 1, 2, 4, 5 and 7-18 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC §112, First Paragraph

Claims 1, 2 and 4-18 have been rejected under 35 USC 112, first paragraph, because the specification, while being enabling for an extensibility controlling meaning, does not reasonably provide enablement for a specific structure or material that inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm. Applicants respectfully traverse the rejection.

“The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916), which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied.” (*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)).

The court in *In re Wands* set out the following list of factors to consider when determining whether the experimentation required to practice an invention is undue or unreasonable. (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. (*Id.*).

“Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations. (*Martek Biosciences Corp. v. Nutrovina*, 579 F.3d 1363 (Fed. Cir. 2009) citing *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (emphasis added).

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“As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.” (*In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (emphasis added). “Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112.” (*Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987), cert. denied, 484 U.S. 954 (1987)).

The Office Action states that “the distinction made by the examiner between enablement of an extensibility controlling means, which is present in the disclosure, and enablement of a specific controlling means . . . implicitly involves application of the Wands factors.” (The Office Action, page 2). While this may be true, an “implicit” application of the Wands factors does not provide a clear record of the reasons for rejection to which Applicants can respond. Therefore, Applicants submit that the Office Action has not properly shown that claims 1, 2, and 4 – 8 lack enablement under 35 U.S.C. § 112, first paragraph.

Applicants appreciate that it is not necessary to discuss each factor in the written enablement rejection. (MPEP §2164.04). But Applicants respectfully remind the Office that the language in the Office Action should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. (*Id.*).

In the present case, it is Applicants’ understanding that the Office has doubt about enablement because information is allegedly missing about one or more essential parts or relationships between parts, which one skilled in the art could not develop without undue experimentation. (See, the Office Action, pages 5 – 6, paragraph #5 and the remarks below). The MPEP clearly sets forth that “[i]n such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.” (*Id.*) (emphasis added). The

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MPEP further states that “references should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). However, specific technical reasons are always required.” (*Id.*) (emphasis added).

In the present rejection, the Office Action asserts that “Applicant discloses only large classes of materials for the topsheet when it functions as the extensibility control means and elastic and inelastic materials for the means when it is not necessarily the topsheet.” (The Office Action, page 3, paragraph #5). The Office Action also asserts that “the type of material the control means is made of and the structural relationship of the extensibility control means with the rest of the components of the article are both simultaneously responsible for the inhibition of the chassis layer.” (The Office Action, page 6) (emphasis in original). Based on these assertions, the Office Action takes the position that one of ordinary skill in the art could not replicate this inhibition without undue experimentation. (*Id.*). However, Applicants must point out that the Office Action has not specifically identified what information is missing nor has the Office Action provided any evidence or specific technical reasoning to show why one of ordinary skill in the art could not provide the absorbent article recited in claim 1 of the present application without undue experimentation. Without this evidence or specific technical reasoning, the Office Action has improperly shifted the onerous burden to the Applicants to prove that their invention is enabled without making a *prima facie* case.

Notwithstanding the lack of the *prima facie* case discussed above, Applicants submit that the present application provides ample disclosure to enable one of ordinary skill in the art to provide the absorbent article recited in claim 1 without undue experimentation. Applicants offer the following remarks in support of this position.

The present application discloses that

The diaper 20 also comprises an extensibility controlling means 70 to control the extensibility of the chassis layer 21. The chassis layer 21 may tear at discontinuities such as slits if the chassis layer 21 is extended beyond the extensibility causing breakage of the chassis layer 21.

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(The present application, page 11, lines 26 – 28). The present application goes on to disclose that “the extensibility controlling means 70 inhibits the chassis layer 21 from extending beyond 20 % at tension force of 125 grams/25mm” (*Id.* at lines 30 – 32).

In the embodiment shown in Figures 1, 4, 5 and 6, the extensibility control means 70 comprises an elastic waist band feature 34 that also facilitates to elastically expand and contract to dynamically fit the wearer's waist. The elastic waist band 34 inhibits the chassis layer 21 from extending beyond extensibility causing breakage of the chassis layer 21 by its resistive force against tension force.

(The present application, page 12, lines 11 – 15) (emphasis added). Additionally, Applicants assert that conventional elastic waist bands are known in the art. (See, e.g., Nakahata at col. 7, line 59 – col. 8, line 19). The present application further discloses that

Alternatively, the extensibility control means 70 may comprise an extensible topsheet material . . . The overall width of the inelastic topsheet when the pleats 24A are extended is limited below the extensibility causing breakage of the chassis layer 21 to inhibit the chassis layer 21 from extending beyond the extensibility causing breakage of the chassis layer 21. Alternatively, the extensibility control means may be . . . an elastic thread, an inelastic thread which is folded before the chaises layer is extended, an elastic film, or an inelastic film which is folded before the chaises layer is extended.

(The present application, page 12, lines 21 – 30).

In view of the foregoing disclosure, Applicants submit that the present application clearly discloses at least one embodiment of an extensibility controlling means that bears a reasonable correlation to the entire scope of this element in claim 1 of the present application. Thus, in accordance with *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970), the enablement requirement of § 112 is satisfied. And as pointed out in *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987), cert. denied, 484 U.S. 954 (1987), “[f]ailure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112.”

Accordingly, Applicants respectfully request that the rejection of claims 1, 2 and 4 – 18 under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

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Rejection Under 35 USC §103(a) Over Nakahata in view of Malowaniec

Claims 1, 2, 4, 5, and 7 – 18 have been rejected under 35 USC §103(a) as being unpatentable over U.S. Pat. No. 5,873,868 to Nakahata, et al. (hereinafter “Nakahata”) in view of U.S. Pat. No. 6,049,915 to Malowaniec (hereinafter “Malowaniec”). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 68 U.S.P.Q.2D 1940 (Fed. Cir. 2003)).

Additionally, an invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. (*KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007)). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” (*Id.*) (emphasis added).

Applicants are unable to find any disclosure in the combination of Nakahata in view of Malowaniec of an extensibility controlling means that inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm. However, the Office Action asserts that this property is inherent to the structure of Nakahata in view of Malowaniec, especially “since the band of the waist feature comprise a material identical to one disclosed by applicant for the elastic band.” (The Office Action, page 3, lines 7 – 10).

Applicants respectfully remind the Office that “a retrospective view of inherency is not a substitute for some teaching or suggestion that supports the selection and use of the elements in the particular claimed combination. In deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art; for that which may be inherent is not necessarily known, and obviousness cannot be predicated on what is unknown.” (*In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir.

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1989) (emphasis added). “Inherency is not necessarily coterminous with knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.” (*Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 77 U.S.P.Q.2d 1321, 1326 (Fed. Cir. 2005) (emphasis added).

Even assuming, for the sake of argument, that the aforementioned properties are inherently present in the combination of Nakahata and Malowaniec, as asserted by the Office Action, the Office Action still has not made a *prima facie* case of obviousness with respect to claim 1. As indicated in the case law cited above, an assertion of inherency cannot be used as a substitute for an element of the *prima facie* case. That is, the Office must still show that one of ordinary skill in the art would be prompted to arrange the elements disclosed in the prior art in the same way that the claimed new invention does (i.e., in a way that provides the claimed parameter). How can it be said that one of ordinary skill in the art would be prompted to combine known elements to provide a claimed parameter when it has not been shown that the parameter is known or recognized in the prior art? Thus, the Office must still provide some objective evidence or reasoning to show that the parameter recited in claim 1 is recognized in the prior art.

In view of the foregoing, it is Applicants’ position that the Office Action has not made a *prima facie* case of obviousness with respect to claim 1 or its dependent claims. Accordingly, Applicants respectfully request that the rejection of claims 1, 2, 4, 5, and 7-18 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

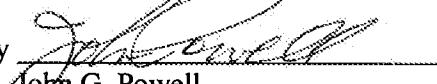
This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied reference(s). In view of the foregoing, entry of the amendment(s) presented herein, reconsideration of this application, and allowance of the pending claim(s) are respectfully requested.

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